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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/804,625

03/09/2001

Elizabeth A. Wang

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EXAMINER

ROMEO, DAVID S

ART UNIT PAPER NUMBER

1647

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/804,625	Applicant(s) WANG ET AL.	
Examiner David S. Romeo	Art Unit 1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 May 2006.
- 2a) This action is FINAL.
- 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 24, 26, 30, 35, 38, 41, 42 and 50-54 is/are pending in the application.
 - 4a) Of the above claim(s) 50-54 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 24, 26, 30, 35, 38, 41 and 42 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 24, 26, 30, 35, 38, 41, 42 and 50-54 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 - 1. Certified copies of the priority documents have been received.
 - 2. Certified copies of the priority documents have been received in Application No. _____.
 - 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

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DETAILED ACTION

The amendment filed 05/08/2006 has been entered. Claims 24, 26, 30, 35, 38, 41–42, and 50–54 are pending.

Newly submitted claims 50–54 are directed to an invention that is independent or distinct
5 from the invention originally claimed for the following reasons: Newly submitted claims 50–54
are directed to a polypeptide, classified in class 530, subclass 350. The invention originally
claimed is directed to a polynucleotide encoding the polypeptide, classified in class 536, subclass
23.5. The polypeptide and polynucleotide are patentably distinct inventions for the following
reasons. Polypeptides, which are composed of amino acids, and polynucleotides, which are
10 composed of purine and pyrimidine units, are structurally distinct molecules; any relationship
between a polynucleotide and polypeptide is dependent upon the information provided by the
nucleic acid sequence open reading frame as it corresponds to the primary amino acid sequence
of the encoded polypeptide. While the polypeptide can be made by methods using the
polynucleotides, it can also be recovered from a natural source using biochemical means. The
15 polynucleotide is not limited in use to production of the polypeptide and can be used as a
hybridization probe, for example. Furthermore, searching the polynucleotide and polypeptide
together would impose a serious search burden. The inventions have a separate status in the art
as shown by their different classifications. In cases such as this one where descriptive sequence
information is provided, the sequences are searched in appropriate databases. There is search
20 burden also in the non-patent literature. Prior to the concomitant isolation and expression of the
sequence of interest there may be journal articles devoted solely to polypeptides which would not
have described the polynucleotide. Similarly, there may have been "classical" genetics papers

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which had no knowledge of the polypeptide but spoke to the gene. Searching, therefore is not coextensive. As such, it would be burdensome to search the inventions together.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 50–54 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 24, 26, 30, 35, 38, and 41–42 are being examined.

New Formal Matters, Objections, and/or Rejections:

Double Patenting

10 Claims 24, 26, 30, 35, 38, 41–42 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 5, 7, 9, and 10 of U.S. Patent No. 5,166,058. Although the conflicting claims are not identical, they are not patentably distinct from each other because the polynucleotides of the application's claims are generic to and fully encompass the longer species of the patent's claims.

15 ***Claim Rejections - 35 USC § 112***

Claim 41 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

20 Claim 41 is indefinite over the recitation of “comprising nucleotides of” because it is unclear if the claimed polynucleotide comprises the nucleotide sequence of the deposited clone or if it comprises an indeterminate portion and arrangement of the nucleotides of the deposited clone. The metes and bounds are not clearly set forth.

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Formal Matters

The application is not fully in compliance with the sequence rules, 37 C.F.R. § 1.821-1.825. Specifically, the claims fail to recite the appropriate sequence identifiers at each place where a sequence is discussed. See 37 CFR 1.821 (d). Nucleic acid sequences with 10 or more nucleotides, at least 4 of which are specifically defined, must comply with the sequence rules. Amino acid sequences with 4 or more residues, at least 4 of which are specifically defined, must comply with the sequence rules. Sequence identifiers can also be used to discuss and/or claim parts or fragments of a properly presented sequence. For example, language such as “residues 14 to 243 of SEQ ID NO:23” is permissible and the fragment need not be separately presented in the “Sequence Listing.”

Correction is required.

Conclusion

No claims are allowable.

ANY INQUIRY CONCERNING THIS COMMUNICATION OR EARLIER COMMUNICATIONS FROM THE EXAMINER SHOULD BE DIRECTED TO DAVID S. ROMEO WHOSE TELEPHONE NUMBER IS (571) 272-0890. THE EXAMINER CAN NORMALLY BE REACHED ON MONDAY THROUGH FRIDAY FROM 7:30 A.M. TO 4:00 P.M. IF ATTEMPTS TO REACH THE EXAMINER BY TELEPHONE ARE UNSUCCESSFUL, THE EXAMINER'S SUPERVISOR, BRENDA BRUMBACK, CAN BE REACHED ON (571) 272-0961.

IF SUBMITTING OFFICIAL CORRESPONDENCE BY FAX, APPLICANTS ARE ENCOURAGED TO SUBMIT OFFICIAL CORRESPONDENCE TO THE CENTRAL FAX NUMBER FOR OFFICIAL CORRESPONDENCE, WHICH IS (571) 273-8300.

CUSTOMERS ARE ALSO ADVISED TO USE CERTIFICATE OF FACSIMILE PROCEDURES WHEN SUBMITTING A REPLY TO A NON-FINAL OR FINAL OFFICE ACTION BY FACSIMILE (SEE 37 CFR 1.6 AND 1.8).

ANY INQUIRY OF A GENERAL NATURE OR RELATING TO THE STATUS OF THIS APPLICATION OR PROCEEDING SHOULD BE DIRECTED TO THE GROUP RECEPTIONIST WHOSE TELEPHONE NUMBER IS (703) 308-0196.



DAVID ROMEO
PRIMARY EXAMINER
ART UNIT 1647